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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/638,234	08/08/2003	Jacques Van Snick	LUD 5582.1 DIV (10019655)	4108
24972	7590	04/10/2006	EXAMINER	
FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198			MERTZ, PREMA MARIA	
			ART UNIT	PAPER NUMBER
			1646	

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/638,234		VAN SNICK ET AL.	
	Examiner		Art Unit	
	Prema M. Mertz		1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-50, 53-59 and 63-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 44-50, 63 and 65-67 is/are allowed.
- 6) ☒ Claim(s) 53-59, 64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Amended claim 44, 53 (3/27/2006), original claims 45-50, 54-59, and new claims 63-67 are under consideration by the Examiner.
2. Receipt of applicant's arguments and amendments filed on 3/27/2006 is acknowledged.
3. The following previous objections and rejections are withdrawn in light of applicants amendments filed on 3/27/2006:
 - (i) the objection to the specification;
 - (ii) the rejection of claim 52 under 35 USC 112, first paragraph as failing to comply with the written description requirement;
 - (iii) the rejection of claims 44-59 under 35 USC 112, first paragraph, scope of enablement; and
 - (iv) the rejection of claims 44-59 under 35 USC 112, second paragraph.
4. Applicant's arguments filed on 3/27/2006 have been fully considered and were persuasive in part. The issues remaining and new issue are restated below.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim rejections-35 USC § 112, second paragraph

6. Claim 64 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 64, line 1, is improper because it recites "wherein said condition in excess lymphomagenesis" rather than the proper "wherein said condition is excess lymphomagenesis".

Claim rejections-Double Patenting

Non-statutory double patenting rejection (obviousness-type)

7. Claims 53-59 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,645,486 ('486).

This rejection is maintained for reasons of record set forth at pages 8-9 of the previous Office action (1/4/2006).

Applicants argue that the amendment to claim 44 is believed to obviate the double patenting rejection since claims 1-11 of US Patent 6,645,486 are drawn to specific conditions as are current claims 44-50. However, contrary to Applicants arguments, claims 53-59 have not been amended by Applicants. Claims 53-59 are generic to claims 1-11 in the patent and encompass subject matter to which the allowed claims are a species because a method for inducing an elevated titer of an antibody specific for IL-9 by administering a conjugate of IL-9 and a carrier encompasses the claimed method in '486 drawn to a method for reducing activity of IL-9 in specific pathological conditions by administering a conjugate of IL-9 and a carrier. However, the patent claims are obvious from the instant claims because the patent claims are directed to specific embodiments encompassed by instant claims 53-59. The patented method is included in instant method claims 53-59.

The patented method claims if infringed upon would also result in infringement of the broad method claims of the instant application. Allowance of the pending claim, therefore, would have the effect of extending the enforceable life of the allowed claims beyond the statutory limit.

Art Unit: 1646

Conclusion

Claims 44-50, 63, 65-67 are allowable.

Claims 53-59, 64 are rejected.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (571) 272-0876. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867.

Official papers filed by fax should be directed to (571) 273-8300. Faxed draft or informal communications with the examiner should be directed to (571) 273-0876.

Information regarding the status of an application may be obtained from the Patent application Information Retrieval (PAIR) system. Status information for published applications

Art Unit: 1646

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Prema Mertz
Prema Mertz Ph.D., J.D.
Primary Examiner
Art Unit 1646
April 6, 2006